

## **REMARKS**

### **Amendments**

Claim 1 is cancelled. Claims 8, 11, and 16-20 are amended to be in independent form, rather than dependent on cancelled claim 1.

Claim 2 is amended to delete superfluous language regarding variable groups  $R^5$ ,  $R^6$ , and L. In addition, claim 2 is amended to delete superfluous language regarding preferences, and to insert carbon atoms ranges for certain groups, e.g., alkyl and alkoxy. See, e.g., text bridging pages 26-27 of the specification. Similar amendments are made to claims 3, 4, 5, and 6. Also, claims 3-6 are amended to insert descriptions of alkoxy-carbonyl and acyl. See, e.g., page 27, lines 14-16 and page 30, lines 4-7. Also, these claims are amended to correct incomplete variable group descriptions. See the definitions of aryl for variable groups  $R^5$  and  $R^6$ . See, e.g., pages 9-13.

The proviso clause in claim 3 is amended to correct typographical errors by deleting the possibility of L being a single bond, and to recite that in L at least one  $-CH_2-$  group is replaced by  $-SO_2NR^6-$  or  $-NR^6SO_2-$  in which  $R^6$  is aryl or arylalkyl which in each case is substituted or unsubstituted. See, e.g., page 32, lines 2-3, and the exemplified compounds.

The proviso clause in claim 4 is also amended to correct a typographical error by deleting the possibility of L being a single bond. A similar amendment is made to the proviso of claim 6. In addition, the proviso in claim 6 recites that L is  $-SO-$ ,  $-SO_2-$ ,  $-CONR^6SO_2-$ ,  $-SO_2NR^6CO-$ , or  $-SO_2NR^6-$ , with the further proviso that when  $R^4$  is at least monosubstituted by  $R^5-L$  in which L is  $-SO_2NR^6-$ , then  $R^6$  is other than H. See, original claim 6, page 32, lines 2-3, and the exemplified compounds.

### **Election and Scope of Elected Subject Matter Searched**

In the Election (September 22, 2005), applicants argued that a Restriction would be improper if it sought to restrict within a single claim. Further, applicants argued that examination should proceed in accordance with MPEP §803.02. In response, the Examiner argues that Restriction, even within a single claim, is proper under 35 USC 121. Applicants disagree.

The Examiner further argues that there has been no improper Markush rejection made here. Applicants agree. But, claims 2-7 of the instant application (claim 1 is cancelled above) are clearly Markush claims, and the criteria for restriction practice relating to Markush-type claims is set forth in MPEP §803.02. This section of the MPEP clearly states that: '[s]ince the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is **improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.**' Thereafter, the MPEP cites *In re Harnish*, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d (Bd. Pat. App. & Int. 1984), i.e., improper Markush cases. Thus, in the case of Markush claims, refusal by the Office to examine that which the applicants regard as their invention, by restricting within a Markush claim, **must be a refusal based on an improper Markush rejection.** The Office Action fails to present any rationale as to why MPEP §803.02 is being ignored in this case.

Applicants respectfully request that the Examiner withdraw the Restriction Requirement which seeks to restrict within a single claim. Withdrawal is particularly urged in light of the Petition Decision (copy enclosed) issued October 25, 2005 in application Serial No. 10/361,634. It is noted that Serial No. '634 was published as US2003/0149052, one of the references used in the Office Action as a basis for a rejection under 35 USC 102(e).

The Examiner in Serial No. '634 similarly sought to impose a restriction within a single claim. Applicants argued that the Restriction was improper and that examination should proceed in accordance with MPEP §803.02. The Examiner maintained the Restriction, and applicants filed a Petition to the Group Director.

In the Petition Decision, the Group Director refuted the position taken by the Examiner and stated that examination should proceed in accordance with MPEP §803.02, as argued by the applicants.

While the examiner states that the "restriction" requirement is supported by the burden placed on the Office of examining the large Markush group, **such reasoning is improper under M.P.E.P. 803.02.**

A review of claim 1 shows that a substituted benzene ring is claimed. The substituents are two alkoxy groups ortho to each other and an amino group para to one of the alkoxy groups. The four radicals of the three groups are generally alkyl or cyclic alkyl groups, but may involve additional substitution. **However, the various species evidence a common core (the substituted benzene ring) and are alleged to have a utility associated with the core structure thus satisfying the criteria set forth in M.P.E.P. 803.02 for making an election of species requirement. When such a requirement is made, the guidelines of M.P.E.P. 803.02 are required to be followed. Creation of a subgenus based on the elected species is not permitted.** In view of the above, the restriction between original Groups I and II is deemed to be an election of species requirement and the examiner's requirement to limit the claims to a subgenus determined by the examiner is withdrawn. (emphasis added)

The Group Director's decision then instructed the Examiner to follow the guidelines of MPEP 803.02 in examining the application.

It is noted that, as in '634, the claimed compounds exhibit a common core (the substituted benzene ring) and are asserted to have a utility associated with the core structure thus satisfying the criteria set forth in M.P.E.P. 803.02 for making an election of species requirement. Applicants again respectfully request that the Restriction be withdrawn and that examination proceed pursuant to MPEP §803.02.

As for Group II, upon determination that subject matter of Group I is allowable, applicants will request rejoinder of the claims of Group II, pursuant to MPEP §821.04.

#### **Rejections under 35 USC 112, second paragraph**

Claim 2 is amended to delete the superfluous definitions of R<sup>5</sup>, R<sup>6</sup>, and L. In addition, claims 3-5 are amended to delete superfluous language from the proviso clauses and to make the definition of R<sup>4</sup> consistent with the proviso clauses. Withdrawal of the rejections is respectfully requested.

**Obviousness-Type Double Patenting Rejection in view of US 6,669,890**

Claims 1, 3, 4, 6, 7, 51, 52, 66, 67, 96, 97, 111 and 112 are rejected on grounds of obviousness-type double patenting in view of claims 1, 2, 4-27, 40, 41, 45 and 66 of US 6,699,890. This rejection is respectfully traversed.

In light of the clarifying amendments above, the claims of the instant application do not overlap the literal scope of the claims of US 6,699,890. The reference to the disclosure at column 9 of US '890 is noted. However, only the claims of US '890, not the disclosure, can be relied on in an obviousness-type double patenting rejection. As for intermediates, it is noted that an alleged similarity in structure does not provide motivation to stop a synthesis process and modify the compounds. See, e.g., *In re Lahu et al.*, 223 USPQ 1257, 1260 (Fed. Cir. 1984).

In view of the above remarks, withdrawal of the rejection is respectfully requested.

**Obviousness-Type Double Patenting Rejection in view of 10/715,819**

Claims 3, 4, 51, 52, 66, 67, 96, and 97, are rejected on grounds of obviousness-type double patenting in view of claims 1-7, 9-19, 31-35, 60, 66, 68 and 69 of US Serial No. 10/715,819. This rejection is respectfully traversed.

In the rejection, it is asserted that claims 1-7, 9-19, 31-55, 60, 66, 68, and 69 of Serial No. '819 anticipate applicants' claims. Applicants disagree. The claims of Serial No. '819 are directed to nitroxide compounds. Thus, the claims of Serial No. '819 do not overlap the literal scope of the claims of the instant application.

In view of the above remarks, withdrawal of the rejection is respectfully requested.

**Obviousness-Type Double Patenting Rejection in view of 10/754,600**

Claims 1, 3, 4, 6, 7, 51, 52, 66, 67, 96, 97, 111 and 112 are rejected on grounds of obviousness-type double patenting in view of claims 1-11, 20-40, 52, 53 and 57 of US Serial No. 10/754,600. This rejection is respectfully traversed.

Serial No. 10/754,600 is a divisional of US 6,699,890, discussed above.

In light of the clarifying amendments above, the claims of the instant application do not overlap the literal scope of the claims of Serial No. '600. The reference to the disclosure at column 6 of the pre-grant publication of Serial No. '600 is noted. However, only the claims of US '600, not the disclosure, can be relied on in an obviousness-type double patenting rejection. As for motivation to modify intermediates, see, e.g., *In re Lahu et al.*, 223 USPQ 1257, 1260 (Fed. Cir. 1984).

In view of the above remarks, withdrawal of the rejection is respectfully requested.

**Rejections under 35 USC 102(e)**

Claims 1, 3, 4, 6, 7, 51, 52, 66, 67, 96, 97, 111 and 112 are rejected as being anticipated in view of US 6,699,890 (Memory-1), 2004/0230072 (publication of Memory-1-D2), and 2003/0149052 (publication of Memory-1-D1).

US 2004/0230072 and US 2003/0149052 are publication of divisional applications of US 6,699,890. In the rejections, the Examiner refers to compounds disclosed by US '890 and its divisionals. These compounds do not anticipate applicants' amended claims. Withdrawal of the rejections is respectfully requested.

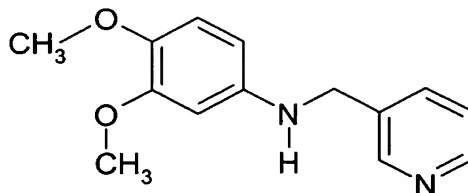
**Rejections under 35 USC 103(a)**

Claim 1 is rejected as being obvious in view of US 6,699,890, 2004/0230072, and 2003/0149052. These rejections are rendered moot by the cancellation of claim 1. Withdrawal of the rejections is respectfully requested.

**Rejection under 35 USC 102(b) in view of FR 2,279,142**

Claims 4, 66 and 67 are rejected as allegedly being anticipated in view of Nadler et al. (FR 2,279,142). This rejection is respectfully traversed.

In the rejection, reference is made to compound D2 at page 17 of FR '142. This compound is of the following formula:



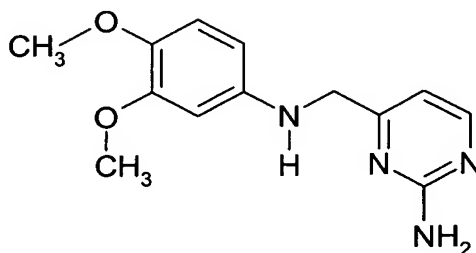
This compound does not anticipate applicants' claim 4, or any of the claims depend thereon. Compare the definition of group R<sup>4</sup> in applicants' claim 4.

In view of the above remarks, withdrawal of the rejection is respectfully requested.

**Rejection under 35 USC 102(b) in view of Banks et al.**

Claims 3, 4, and 6 are rejected as allegedly being anticipated in view of the article by Banks et al. This rejection is respectfully traversed.

In the rejection, reference is made to compound of formula 12, 2-amino-4-(3',4'-dimethoxyanilino)-pyrimidine, which has the following formula:



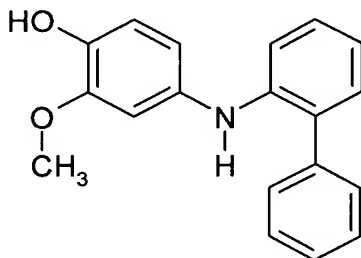
This compound does not anticipate applicants claim 3, 4, or 6. Compare the definition of group R<sup>4</sup> in applicants' claims 3, 4, and 6.

In view of the above remarks, withdrawal of the rejection is respectfully requested.

**Rejection under 35 USC 102(b) in view of Kondo et al. (US 4,542,373)**

Claims 1, 3, 4, and 6 are rejected as allegedly being anticipated in view of the article by Kondo et al. (US 4,542,373). This rejection is respectfully traversed.

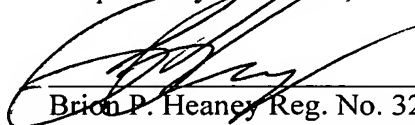
In the rejection, reference is made to the 4-(o-biphenyl)aminophenol compound of Example 80, wherein, as shown in Table 6, X is methoxy, Y is H, and R<sub>5</sub> is H. This compound has the following formula:



This compound does not anticipate applicants claim 3, 4, or 6. Compare the proviso clause in applicants' claims 3, 4, and 6. The rejection of claim 1 is rendered moot by the cancellation of the claim. In view of the above remarks, withdrawal of the rejection is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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